

## REMARKS/ARGUMENTS

At para. 3 of the Office Action of November 9, 2006, claims 1-6 and 9-11 were rejected under 35 U.S.C. 103(a) as being unpatentable over Kato et al or Nakazono et al in view of Chenoweth and Bloom. This ground of rejection is courteously traversed.

Page 3 (top Paragraph) of the Office Action concedes Nakazono et al ( as well as Kato et al) do not disclose a base comprising elevations operatively arranged for providing additional support for the (packaged) article according to Applicant's claims. Notwithstanding the omissions of the primary references, the Office Action concludes it would still be obvious under Section 103 to modify the packaging tray of Nakazono et al (or Kato et al) in view of the teachings of Chenoweth or Bloom.

Applicant courteously disagrees.

Although not very well illustrated by the drawings of Nakazono et al, the text at col. 7, lines 60-65 of Nakazono et al expressly teaches:

“In the above arrangement, when the LC panel 2 is placed in the packaging tray to be transported, as shown in Fig. 2, the peripheral components of the LC panel 2 are placed in the peripheral component holding concave portion 6 first, and thence the LC panel 2 is placed in the LC panel holding concave portion 3.” (Emphasis added)

In addition to the above quoted portion from Nakazono et al, this reference also expressly teaches at col. 5, lines 12-15:

“A peripheral component holding concave portion 6 for holding peripheral components of the LC panel 2 is provided inside the LC panel holding concave portion 3.”

Thus, Nakazono et al make it quite clear by expressly teaching that inside the LC panel holding concave portion 3, there is a further component holding concave

portion 6 below for holding peripheral components inside the LC panel holding portion. However, concave portion 6 is first filled with the peripheral components.

Accordingly, whether or not Chenoweth or Bloom may teach additional elevations for supporting the bottom surface for an article, Applicant maintains that it would not be obvious under 35 U.S.C. 103(a) to one of ordinary skill in the art to introduce such base elevations especially into the packaging tray of Nakazono et al because Nakazono et al make clear the space in inner concave portion 6 is needed for storing peripheral components. The introduction of such elevations of Chenoweth/Bloom into the packaging of Nakazono et al would operate to preclude concave portion 6 of Nakazono et al from being utilized for packaging the peripheral components of the LC panel intended by this reference because the **elevations**, as proposed by the examiner, would otherwise occupy this space and preclude utilizing concave portion 6 for packaging peripheral components as intended by Nakazono et al. In order to arrive at a conclusion of obviousness, one must consider all aspects of the prior art, including teachings which might otherwise teach away from a conclusion of obviousness.

Once again, the Office Action acknowledges at the top portion of page 3 that Kato et al, like Nakazono et al, also do not teach base elevations operatively arranged for providing additional support for their articles (slides) in accordance with Applicant's claim 1, etc. This is because of the packaging application taught by Kato et al is a carrier tape for packaging semiconductors.

More specifically, the packaging of Kato et al is fabricated from a pliable carrier strip or tape with sprocket perforations on one side for accurate feed control for use in protective packaging of semi-conductor devices after manufacturing. This is discussed at col. 1, beginning at line 46, and bridging to col.2.

Assuming Bloom and Chenowith teach base elevations as the Office Action alleges, Kato et al would still effectively teach away from the use of such elevations in

their packaging according to Applicant's claim 1. This is because Kato et al are striving to protect semi-conductor electrodes "Sa" from making contact with the bottom surface structures in their receiving recesses. This is best illustrated by Fig. 2 of Kato et al, wherein Sa electrodes are illustrated, and are discussed at col. 7, lines 46-50. Base elevations, according to Chenoweth and Bloom, in the semi-conductor packaging, according to Kato et al would be inappropriate because Kato et al are striving to protect electrodes on the bottom side of their packaging from contact and possible damage from occurring. The base elevations of Chenoweth and Bloom would be avoided by Kato et al due to the potential for damage occurring to the semi-conductor electrodes in the lower compartment making contact with such structural elevations, as proposed by the examiner. It will be observed from the drawings of Kato et al the lower compartment is open and free of structures which might otherwise engage and damage the electrodes of the semiconductors. This is not surprising in view of Kato et al's objective of protecting the lower electrodes of the semiconductors from damage.

Hence, as in the case of Nakazono et al, it would also be nonobvious over the teachings of Kato et al in view of Chenoweth and Bloom to introduce supporting elevations in the base structure, according to applicant's amended claim 1, and claims dependent therefrom.

In addition to claim 1, claims 2-6 and 9-11 are directly or indirectly dependent from claim 1, and therefore, include all the structural features of claim 1, plus any additional limitations from intervening claims. Consequently, dependent claims 2-6 and 9-11, likewise should also be patentable over the combination of Kato et al or Nakazono et al in view of Chenoweth and Bloom.

In paragraph 4 of the Office Action, claim 7 was rejected under 35 U.S.C. 103(a) as unpatentable over the references as applied to claim 1 (Kato et al or Nakazono et al in view of Chenoweth and Bloom) in view of Official Notice and Anthony '989, newly cited. This ground of rejection is courteously traversed.

Paragraph 4 of the Office Action expressly states Kato et al and Nakazono et al fail to show two grip recesses in the region of the front wall. While Applicant agrees that Kato et al fail to teach the concept of grip recesses, Applicant totally disagrees with respect to Nakazono et al. In this regard, Fig. 9 of Nakazono et al clearly teaches grip recesses 29 located in the frontwall and backwall of packaging tray 1, and not on the sidewalls, as recited by Applicant's amended claim 7. In this regard, claim 7 has been amended to include the language of Original claim 12, i.e., **...grip recess is formed in the left and right sidewall close to the front wall.--** Consequently, claim 7, as currently amended does not raise any new issue of subject matter not previously presented for the examiner's consideration. Claim 7 should be entered because it does not raise any new issues or require further searching by the examiner. Besides, the language of amended claim 7 places the claim in condition for allowance.

In assessing patentability, it is axiomatic, the examiner is required to consider **all portions of a reference including those which teach away from Applicant's claimed invention, and supports a conclusion of non-obvious, patentable subject matter**. In this regard, Nakazono et al, a primary reference relied on in rejecting claim 7, clearly suggests that packaging trays when employing grip recesses, they should be located in the front and rear walls of the tray. Any conclusion to the contrary, i.e., placement of the grip recesses into the sidewalls close to the front wall according to Applicant's claim 7 would constitute hindsight reconstruction, prohibited under Section 103, and also under numerous Court holdings. The grip recesses taught by Nakazono et al would be inoperative in Applicant's transport container, as demonstrated by Applicant's Fig. 6. Applicants backwall 52 engages with equipment, such as treatment station 16, which would render a grip recess located in the backwall like recess 29 of Nakazono et al unusable.

Similarly, the recesses taught by Anthony et al would still not meet Applicant's amended claim 7 because the recesses are positioned in the **central portion of the sidewalls** of the storage box, and not close to the frontwall.

Finally, the examiner's Official Notice alleged as a substitute for published prior art is without merit. Applicant's last response contested the conclusion of Official Notice because this structural feature is not believed to be so well known that prior art need not be cited in support thereof. In response thereto, the examiner cites Anthony et al, as supplemental published prior art.

However, this reference (Anthony et al), as stated above, does not meet the criteria of rejected claim 7 because Anthony et al fail to teach or suggest a transport container with two grip recesses in the sidewall that are also close to the frontwall arranged opposite one another. As previously stated, Anthony et al expressly teach recesses 28 in the central portion of their tray for gripping purposes. However, Applicant's claim 7 expressly requires his to be oppositely positioned grip recesses to **be located close to the front wall (51)** because the mid-portion of sidewalls 53-54 of Applicant's transport container requires central openings to accommodate tray clamps 28a (See Fig. 5) . **Consequently, the location of the recesses suggested by Anthony et al in the mid-region of their storage tray will not be suitable for use according to Applicant's claimed invention.**

Accordingly, reconsideration and withdrawal of the rejection of claim 7 as unpatentable over the references as applied to claim 1 (Kato et al or Nakazono et al in view of Chenoweth and Bloom) in view of Official Notice and Anthony '989, newly cited are courteously requested.

In par. 5 of the Office Action, claim 8 was rejected under 35 U.S.C. 103(a) as unpatentable over the references as applied to claim 1 (Kato et al or Nakazono et al in view of Chenoweth and Bloom) further in view of Lafond et al or Burton et al . This ground of rejection is respectfully traversed.

Claim 8 is directly dependent from claim 1 and includes all the limitations of claim 1 relating to a transporter for slides, plus a base comprising elevations for additional support for the slides. And, for reasons outlined above, especially in connection with

Nakazono et al and Kato et al and why elevations of Chenoweth and Bloom would be inappropriate in the packaging trays of Nakazono et al and Kato et al. Claim 8 likewise would be patentable. Lugs 63 of Applicant's tray perform as guides for arranging the transport containers in a stack, whereas tabs 103 and 107, according to Burton et al, are hold-down tabs for snap fitting engagement with detent ridge 28 of lid 10. By contrast, Applicant's lugs are not snap-fittings for holding structures together, but instead are stacking guides for multiple trays. Applicant's lugs 63 perform a different function from the hold-down tabs of Burton et al. This is plainly evident from Figs. 5A and 5B of Burton et al., illustrating tabs 103 and 107 engaging with detent ridge 28 for a snap-fit closure between JEDEC tray and lid 10.

Lafond et al disclose a transporting tray for microscope specimen slides having substantially different structural features than those of Applicant. While Lafond et al employ parallel projecting members 38 and 44 arranged at different planes designed specifically for preventing longitudinal sliding movement of the trays, neither Lafond et al, nor Burton et al offset the deficiencies of Nakazono et al and Kato et al taken with Chenoweth and Bloom as to make out a *prima facie* case of obviousness under 35 U.S.C. 103(a).

Accordingly, reconsideration and withdrawal of the rejection of claim 8 are courteously requested.

Applicant also wishes to highlight for the record, the fact that the rejection of claim 8, like that of the rejection of claim 7, is based upon a collection of not fewer than **six (6) references**, namely Nakazono et al, Kato et al, Chenoweth, Bloom, Burton et al and Lafond et al. Such a large collection of art, while disclosing some of the structural elements of Applicant's claimed transport container, the need for the examiner to cite such a thicket of references, and still **not** make out a *prima facie* case of obviousness is actually probative evidence of **nonobviousness**, and the presence of patentable subject matter. The examination process while intended to identify

unpatentable subject matter, the examiner's job is also to identify and allow claims reciting patentable subject matter.

At paragraph 6 of the Office Action, claim 12 was rejected under 35 U.S.C. 103(a) as unpatentable over Nakazono et al in view of Official Notice and Anthony et al. This ground of rejection is courteously traversed.

**For the reasons outlined above in connection with the rejection of claim 7, Applicant maintains claim 12 is also patentable.**

**As pointed out above in connection with claim 7, Nakazono et al teach grip recesses 29 (Fig. 9) positioned in the back and front walls of packaging tray 1.** This primary reference fails to teach or suggest "grip recess" 29 formed in the sidewalls close to frontwall, in accordance with claim 12. As stated above in connection claim 7, Applicant's grip recesses must be positioned in the sidewalls, but also must be positioned in proximity to the frontwall. No prior art has been cited suggesting gripping notches 29 (Fig. 9) of Nakazono et al should be positioned in the sidewalls close to the frontwall according claim 12. Anthony et al do not teach or suggest placement of their gripping recess close to an end wall, but positions their gripping recess in the center of their sidewalls. In addition, placement of the gripping recess 29 in the backwall as taught by Fig. 9 of Nakazono et al in Applicant's transport container (Applicant's Fig. 6) will interfere with the stackability of Applicant's trays due to the presence of lugs 63 on backwall 52 (Applicant's Fig. 6), rendering the backwall gripping notch inoperative.

Even if Nakazono et al, Anthony et al and Official Notice are taken together, the device of claim 12 would still not be arrived at because there would still not be a teaching of a "grip recess formed in the left and right sidewall close to the front wall."

Accordingly, reconsideration and withdrawal of the rejection of claim 12 under 35 U.S.C. 103(a) as unpatentable over Nakazono et al in view of Official Notice and Anthony et al are courteously solicited.

In Par. 7 of the Office Action, claim 13 was rejected under 35 U.S.C. 103(a) as unpatentable over Nakazono et al in view of Lafond et al or Burton et al. This ground of rejection is courteously traversed.

The rationale for combining Nakazono et al with Lafond et al remains doubtful, at best. For example, the Office Action admits **Nakazono et al fail to teach parallel lugs at the backwall which serve as guide for arranging the transport container of Nakazono et al as a stack.** But, then highlights Lafond et al as basis for modifying the packaging tray of Nakazono et al. without providing any rationale for introducing lugs 38 and 44 of Lafond et al into the packaging of Nakazono et al. In this regard, it is well established that obviousness cannot be arrived at by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggesting or incentive supporting the combination. *In re Geiger* 2 USPQ2d 1276, 1277 (CAFC 1987)

In effect, the examiner is attempting to introduce a single specific structural feature of Lafond et al based solely on the fact that Applicant's claim 13 happens to recite this limitation, which admittedly is not taught by Nakazono et al, the primary reference. Before such feature may be introduced into the packaging of Nakazono et al, the examiner has the burden to show some teaching suggestion or incentive for combining the references, which he has not done. *In re Geiger supra.*

In this regard, Lafond et al teach in col. 1, lines 55-59, that **"locking means integral with one of the end walls of the body adapted to contact corresponding locking means on the upperposed and underposed bodies to prevent longitudinal sliding movement relative to one another;"**. Lafond et al are describing projecting members 38 and 44, and also refer to Fig. 4 in col. 2, lines 60-66 where they mention



longitudinal sliding movement of container 12 in the direction of arrow 70, and the locking effect of projecting member 44 of container 12 sliding on the rounded back 38a of the projecting member 38 of container 12' for purposes of preventing unwarranted longitudinal sliding movement of one modular container relative to another.

Upon examining Nakazono et al, it will be observed this reference already discloses structural features for controlling longitudinal sliding movement of modular packaging trays relative to one another. In this regard, according to Col. 2, lines 50-53 of Nakazono et al expressly states:

“It is therefore an object of the present invention to provide a packaging tray which can avoid the damages to a display element held therein caused by the displacement of the stacked packaging trays during the transportation.”

According to Nakazono et al at col. 6, line 37-50 teach:

“The position determining concave portion 11 is made into a cross in the plan view because the cross composed of four arm portions is the optimal shape when the readiness (work efficiency) in separating the stacked packaging trays 1 and the position fixing properties of the packaging tray 1 are concerned. More specifically, the bottom surface area of the cross position determining concave portion 11 can be reduced as much as possible compared with circular or triangular position determining concave portions 11 of the same size, and the stacked packaging trays 1 can be readily separated. On the other hand, the cross shape composed of four radial arm portions can prevent the displacement of the packaging trays 1, especially in the horizontal direction in a reliable manner.” (Emphasis added)

Col. 12, lines 48- 57 of Nakazono et al also describe how the “four radial arm portions” effectively prevent the displacement of the packaging trays, “**especially in the horizontal position**”. Because the structural features of Nakazono et al relative to

the resistance of the trays to horizontal or longitudinal movement are already well documented throughout the Nakazono et al reference, it is quite unclear why it would be obvious under Section 103 to introduce the projecting members 38 and 44 of Lafond et al for the same purpose again into the trays of Nakazono et al.

In essence, the absence of any valid rationale or suggestion for substituting the lugs/elevations of Lafond et al for the horizontal movement controlling “four arm portions” of Nakazono et al already disclosed by Nakazono et al raises a strong presumption the examiner’s conclusions are based on impermissible hindsight reconstruction where the substitution becomes apparent after having the benefit of a prior reading of applicant’s own disclosure.

With regard to Burton et al, tabs 103 and 107 are structurally dissimilar to Applicant’s lugs 63, which are adapted for arranging multiple transport containers into a stack. Tabs 103 and 107 of Burton et al are adapted as hold-down tabs for lid 10. Tabs 103 and 107 of Burton et al are adapted for snap fitting engagement with detent ridge 28 of lid 10. Importantly, Applicant’s lugs are not snap-fittings for holding structures together. Applicant’s lugs 63 are adapted to perform a different function from the hold-down tabs of Burton et al. This is plainly evident from Figs. 5A and 5B of Burton et al., illustrating tabs 103 and 107 engaging with detent ridge 28 for a snap-fit closure between the JEDEC tray and lid 10.

In sum, it remains unclear to Applicant what motivation there would be to substitute the projecting members of Lafond et al or Burton et al for the system already disclosed by Nakazono et al for preventing horizontal movement of trays, other than impermissible hindsight from a prior reading of Applicant’s own disclosure.

Accordingly, reconsideration and withdrawal of the rejection of claim 13 as unpatentable over Nakazono et al in view of Lafond et al or Burton et al are courteously solicited.

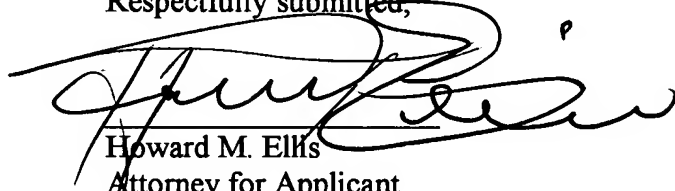
Claim 14 has been cancelled without prejudice.

#### SUMMARY

In summation, this paper provides for amending only claim 7, wherein the change in language relating to the grip recess is taken from unamended claim 12. The language of claim 7, wherein the grip recess is formed in the right and left sidewalls close to the front wall --- does not raise a new issue because this language was previously considered during examination of claim 12. Entry of this amendment should be permitted because this paper clearly presents reasons why the claims are distinguishable over the references cited without raising any new issues or presenting limitations not previously considered in previous Actions.

Favorable reconsideration is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Howard M. Ellis", is written over a horizontal line.

Howard M. Ellis  
Attorney for Applicant  
Reg. No. 25856  
(716)626-1564

January 9, 2007